

**REMARKS**

Claims 13-15 and 17-20 have been allowed. Claims 21-26 have been added. Thus, claims 1-9 and 13-26 are pending in the present application. No new matter has been incorporated by way of these new claims, because each new claim is supported by the present specification. For example, support for all new claims 21-26 can be found in the written description at page 12, lines 24-27. Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

**Issues Under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-9 and 16 under 35 U.S.C. § 103(a) over Minoru '401 and Masahiko '904 or Carstairs '857. However, Applicants note that only claims 1-3 and 6-12 were at issue under this section of 35 U.S.C. in the Office Action of July 31, 2001. Thus, the rejection of claims 4-5 is a new rejection. Accordingly, because this new rejection was not necessitated by the Applicants' amendment to these claims, the Examiner is requested to withdraw the

finality of the outstanding Office Action and to make the same non-Final. See 37 C.F.R. § 1.113; MPEP § 706.07.

Applicants also respectfully traverse the rejection of claims 1-9 and 16.

#### The Present Invention and Its Advantages

The present invention provides a freshness-keeping composition for plants comprising a surfactant (A), and at least one of the following components (B)-(F): a sugar (B), a plant hormone (C), an aging inhibitor (D), an aggregating agent for colloidal particles (E), or a germicide, fungicide and preservative (F). Component (A) has surfactant activity with a sugar or sugar alcohol skeleton in a molecule.

The Applicants have found that there are synergistic advantages in employing component (A) with at least one of components of (B)-(F). As a result of the above combinations, the claimed composition creates an improved freshness-keeping effect and safety over conventional compositions. Further, the freshness-keeping agent can be added to another freshness-keeping agent or life-prolonging agent that is commercially available and conventionally used.

Distinctions Over the Cited References

Applicants respectfully submit that a *prima facie* case of obviousness has not been established for the following reasons.

(A) *Lack of Motivation and Teachings in the Cited Art*

The references of Minoru '401 and Masahiko '904 or Minoru '401 and Carstairs '857 fail in combination to disclose or suggest a composition of surfactant (A) with at least one of the components (B)-(F).

Minoru '401 simply discloses one component of the present invention, which is an alkylglucoside (corresponding to (A)). Similarly, Masahiko '904 merely discloses a composition or method comprising trehalose (corresponding to (B)), and Carstairs '857 simply discloses a composition and method comprising gibberellin (corresponding to (C)). Applicants even discuss the Masahiko '904 reference as disclosing a single component in the present specification (see page 2).

Applicants respectfully assert that the cited references at best simply disclose single components of the present invention, and not the instantly claimed combinations of (A) plus one of (B)-(F).

Further, Applicants maintain their position that the cited references provide no motivation or reasonable expectation of success to arrive at a combination composition as instantly claimed invention,

because Minoru '401 could not lead to the present invention when combined with either Masahiko '904 or Carstairs '857.

Applicants hereby submit a Declaration by Mr. Tadayuki Suzuki, one of the co-inventors, as evidence of that Minoru '401 can not be properly combined with either Masahiko '904 or Carstairs '857.

Minoru '401 is directed to a plant aroma enhancer. The USPTO has utilized this reference for disclosure of a perfume glycoside. However, Minoru further discloses that 0.5 wt% of alkylglycoside is to be used to enhance the aroma of a plant.

Thus, Applicants have conducted comparative testing where the 0.5 wt% of the alkylglycoside is used as a proper comparison to the present invention. As can be seen in the Declaration, this concentration of 0.5 wt%, when combined with a component (B) or (C) as instantly claimed, does not preserve the freshness of the plant (see Tables 22 and 23, right columns). This is because a composition of 0.5 wt% of alkylglucoside, as disclosed in Minoru '401, is too thick to preserve the freshness of a plant.

In other words, the present invention cannot be achieved in view of the disclosure of Minoru '401, because 0.5 wt % of component (A) does not work. If one having ordinary skill in the art could hypothetically have the requisite motivation and reasonable expectation of success by combining the cited references, that person would achieve a composition having 0.5 wt% of component (A). But such a composition

would not achieve the synergistic advantages of the present invention. Thus, Minoru '401 cannot be properly combined with either Masahiko '904 or Carstairs '857, because Minoru '401 teaches an incompatible or ineffective ingredient.

Therefore, Minoru '401 actually teaches away from achieving the present invention because the sole ingredient of Minoru '401 (component (A)) cannot achieve the present invention or its advantages. Besides Minoru '401 teaching a sole component of the present invention, this teaching away that is present in Minoru '401 is an additional reason why the present invention is patentable over this cited reference (and combinations thereof).

Further, the synergistic results achieved by the present invention rebut any asserted *prima facie* case of obviousness.

(B) *Objective Evidence of Nonobviousness Rebuts the Asserted Prima Facie Case of Obviousness*

A proper inquiry under 35 U.S.C. § 102(a) also requires any objective evidence of patentability. See *Graham v. John Deere Co.*, 148 USPQ 459, 467 (1966). In view of the objective evidence of synergistic results, a *prima facie* case of obviousness cannot be maintained.

This is because the present invention of combining component (A) with at least one of (B)-(F) gives synergistic advantages, where

these unexpected results rebut any asserted *prima facie* case of obviousness. Even if, *arguendo*, one skilled in the art had any motivation and reasonable expectation of success in combining the cited references, Applicants have shown that the present invention achieves results beyond anything that could be expected.

Applicants respectfully refer the USPTO to the comparative data in the present specification (see Tables 1 and 9 comparing inventive products 13, 49, 53, 54, 56, versus comparative products 10 and 30 of trehalose and gibberellin, respectively). This comparative data clearly demonstrates that the combination of the component (A) and at least one of components (B)-(F) gives synergistic advantages of better growth and freshness conditions of various plants (see the experimental results in Tables 2 and 4). These are results that are considered unexpected.

Applicants also refer the USPTO to the submitted Declaration by Mr. Tadayuki Suzuki as evidence of patentability. The Declaration clearly demonstrates that Minoru '401 teaches a compound with no preservation-capability. It is obvious that the data in Tables 22-23 indicate that the present invention achieves synergistic and unexpected results over the composition having 0.5 wt% of component (A) as disclosed by Minoru '401.

The comparative data in the specification and the submitted Declaration are two instances of evidence supporting the patentability of the present invention.

Thus, Applicants have demonstrated that the present invention has achieved unexpected results and that the Minoru '401 reference has been improperly combined with Masahiko '904 or Carstairs '857.

Applicants also note their previous comments, that if one having ordinary skill in the art could have the requisite motivation and reasonable expectation of success by combining the cited references, that person would not achieve the synergistic advantages of the present invention. Instead, that person having ordinary skill in the art would be left with an ineffective composition that is too thick to preserve a plant.

Thus, the only way to achieve the present invention is to reach the present specification, review what is being claimed, and using hindsight reconstruction by combining reference A with reference B and/or C.

However, this reconstruction is contrary to case law when the USPTO has simply chosen elements from cited art after considering the instant disclosure in order to come up with the surfactant (A), and at least one of the following components (B)-(F) as presently claimed. The USPTO has, therefore, relied on an impermissible level of "hindsight reconstruction" as a basis of support of the instant

rejection. As stated by the Federal Circuit in *Sensonics Inc. v. Aerosonic Corp.* 38 USPQ2d 1551 (Fed. Cir 1996):

To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

Further, the existence of unexpected results clearly demonstrates that the claimed combination of surfactant (A) and at least one of components (B)-(F) could not have been obvious to one having ordinary skill in the art. At best, the combination of these references, whether proper or not, would only lead to many possible combinations.

Likewise, it is noted that an "invitation to explore" cannot form a basis for an Examiner's rejection under 35 U.S.C. § 103(a). See *Ex parte Obukowicz*, 27 USPQ2d 1063 (BPAI 1992). In other words, picking and choosing elements from the cited references to achieve the presently claimed combination of ingredients (A) and at least one of components (B)-(F) equals an impermissible invitation to explore. See also *Orthopedic Equip. Co., Inc. et al. v. United States*, 217 USPQ 193, 199 (Fed. Cir. 1983) ("It is wrong to use the patent in suit as a guide through the maze of prior art references, combining

the right references in the right way so as to achieve the result of the claims in suit.").

Thus, Applicants respectfully submit that the present invention has subject matter that is patentably distinguishable from the cited references. Specifically, the present claims incorporate patentable subject matter over the Minoru '401 reference and Masahiko '904 or Carstairs '857 in combination. Therefore, Applicants respectfully request the Examiner to withdraw all rejections and allow the currently pending claims.

**Allowable Subject Matter**

Applicants note that claims 13-15 and 17-20 have allowable subject matter.

A full and complete response has been made to the Office Action. The Examiner is respectfully requested to pass the application to issue. Further, the Examiner is respectfully requested to enter this Reply After Final in that it raises no new issues.

Alternatively, the Examiner is respectfully requested to enter this Reply After Final in that it places the application in better form for Appeal.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of

the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

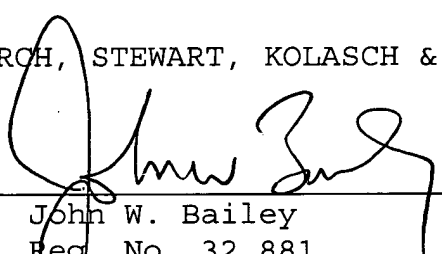
Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

  
John W. Bailey  
Reg. No. 32,881

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

  
JWB/ETP

Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

**IN THE CLAIMS:**

Claims 21-26 have been added.